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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/438,630	11/12/1999	NAOKI MURAYAMA	SONYJP-3.0-0	9638
530	7590	05/06/2005	EXAMINER	
<b>LERNER, DAVID, LITTENBERG, KRUMHOLZ &amp; MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090</b>				ONUAKU, CHRISTOPHER O
		ART UNIT		PAPER NUMBER
		2616		

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/438,630	MURAYAMA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Christopher O. Onuaku	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 December 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 11-24 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 11-24 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/10/04 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 11-24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohara et al (US 6,292,618) in view of Saib et al (US 6,292,624).

Regarding claim 11, Ohara et al disclose an image recording and reproducing apparatus capable of recording and reproducing both of digital and analog signals, including a reference signal necessary to display a state of the image recording and reproducing apparatus in a picture and an operation method of the image recording and reproducing apparatus, comprising:

- a) a receiver section for receiving digital television signals ( see Fig.1&3 and IRD 200; col.3, lines 58-64 and col.4, line 63 to col.5, line 39);
- b) a communication line for receiving digital television signals reproduced and transmitted from an external storage device (external storage device reads on the VTR 100 of Fig.1) (see Fig.1, communication line 270 that connects the IRD 200 to the VTR 100; col.5, lines 44-46) ;
- c) an on-screen display processor for generating an on-screen displays from the digital television signals received from the receiver section and from the external storage device, the on-screen display processor being adapted to generate a first on-screen display on a first screen representing a description of a television program currently received by the receiver section and a second on-screen display on a separate, second screen representing a description of television programming which is reproduced and transmitted by the external storage device through the digital interface (see analog on-screen display circuit 15 of Fig.1, col.4, lines 14-25, col.6, lines 1-15 and co.6, line 64 to col.7, line 20; and digital OSD circuit 2032 of Fig.3, col.5, lines 29-38 and col.6, lines 16-45). In col.17, lines 15-60, Ohara discloses the recording process of recording digital broadcast signal during which the received broadcast program is

recorded and displayed for viewing on the TV 250 by the OSD circuit 15. In col.18, lines 30-63, Ohara discloses the reproducing process of reproducing recorded digital broadcast signal during which the recorded digital broadcast program is reproduced and displayed for viewing on the TV 250 by the OSD circuit 15. And in col.21, lines 19-57, Ohara discloses the process of superimposing information during digital recording and reproducing operations. here examiner reads the second on-screen display as the display of the EPG information, and the first on-screen display as the display of a program selected for viewing by the user from the EPG information, and the EPG information is externally received from the cable 22 or DBS 24, for example, each of which includes storage means for storing programming information.

Ohara fails to disclose a digital interface for receiving digital television signal reproduced and transmitted from an external storage device. Furthermore, Ohara fails to disclose wherein the first on-screen display being superimposed on the television program being received by the receiver, and the second on-screen display being superimposed on the television program being reproduced and transmitted by the external storage device.

Saib et al teach a system and method for selectively recording a show without using a timer set-up screen comprising, as shown in Fig.3, the IRD 310, the VCR 330, the television receiver (TV) 320 and communication line 325 that connects the IRD 310 to the TV 320 and the communication line 335 that connects IRD 310 to the VCR 330 (see col.3, line 33 to col.4, line 7). In col.4, line 64 to col.5, line 10, Saib teaches an interface 415 which complies with IEEE-1394 standard that connects the IRD 310 to

digital-input peripheral devices such as VCRs. Connecting digital electronic devices through a digital interface that complies with the IEEE 1394 standard provides the desirable advantage of connecting the digital devices with IEEE-1394 interface which complies with the IEEE-1394 standard. It would have been obvious to modify Ohara by realizing Ohara with digital interface IEEE-1394 in order to connect the Ohara digital devices (e.g., IRD or VTR, for example), since this provides the desirable advantage of connecting the digital devices with IEEE-1394 interface which complies with the IEEE-1394 standard.

Furthermore, Saib teaches the principle of superimposing, during recording, for example, the electronic program guide on a current-broadcast show selected by the user from the superimposed EPG, and wherein the selected show is displayed as background display (see col.6, lines 24-58).

It would have been obvious to apply the principle of superimposing program information, for example, on a user-selected program being displayed, as taught by Said, in order for the user, for example, to be ensured that the program the user selected is the program being displayed. It also would have been obvious to apply similar superimposition principle on a received program as well as a recorded program being reproduced, in order to satisfy the user that the program the user is reproducing is the selected program.

Regarding claim 12, Ohara modified with Saib discloses wherein the first and second on-screen displays are substantially the same but at least one of the on-screen

displays includes an indicia element to distinguish between the on-screen. As discussed in claim 11, above, Ohara discloses wherein both the first and second on-screen display are displayed on the TV 250 (see col.17, lines 46-60 and col.18, lines 42-63). And when , following the superimposition principle of Saib, inherently, the EPG superimposed on the received or reproduced program would include an indicia.

Regarding claim 13, Saib further teaches wherein the digital television signals received by the receiver section include television program guide information (see col.6, lines 24-58).

Regarding claim 14, Sampsell discloses wherein the digital television signals reproduced and transmitted from the external storage device include television program guide information (see preengagement picture of Fig.9 which examiner reads as a program guide; col.9, lines 33-46 and col.12, line 55 to col.13, line 23).

Regarding claim 15, Sampsell discloses wherein the on-screen display processor processes the television program guide information included in the reproduced digital television signals to generate the second on-screen display and omits unnecessary information from the television guide information (see claim 14 discussions above and col.13, lines 11-27), when the program guide information is displayed, the user selects from the program guide information the program desired by the user, leaving any other programming information on the program guide information as unnecessary information.

Regarding claim 16, the claimed limitations of claim 16 are accommodated in the discussions of claim 11 above.

Regarding claim 17, the claimed limitations of claim 17 are accommodated in the discussions of claim 12 above.

Regarding claim 18, the claimed limitations of claim 18 are accommodated in the discussions of claim 13 above.

Regarding claim 19, the claimed limitations of claim 19 are accommodated in the discussions of claim 14 above.

Regarding claim 20, the claimed limitations of claim 20 are accommodated in the discussions of claim 15 above.

Regarding claim 21, the claimed limitations of claim 21 are accommodated in the discussions of claims 11&12 above. Here, as discussed in claims 11&12 above, the first on-screen displays the program desired and selected from the EPG information, wherein the claimed indicia include the program name, the channel carrying the program, the program start/end times, which are inherent in a scheduled program in order to identify the program; and the second on-screen display displays the EPG

information, wherein the second set of indicia includes the identification parameters of the programs contained in the EPG information, and examiner reads the claimed distinguishing indicia element as the channel that is carrying a program.

Regarding claim 22, the claimed limitations of claim 22 are accommodated in the discussions of claim 11 above, including the discussions on the superimposition (overlaying) processes of Ohara and Saib.

Regarding claim 23, the claimed limitations of claim 23 are accommodated in the discussions of claim 22 above.

Regarding claim 24, the claimed limitations of claim 24 are accommodated in the discussions of claim 22 above.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from this examiner should be directed to Christopher Onuaku whose telephone number is (571) 272-7379. The examiner can normally be reached on Tuesday to Thursday from 7:30 am to 5:00 pm. The examiner can also be reached on alternate Monday.

If attempts to reach the examiner by telephone is unsuccessful, the examiner=s supervisor, Andrew Faile, can be reached on (571) 272-7375.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

and (for informal or draft communications, please label "PROPOSED" or  
"DRAFT")

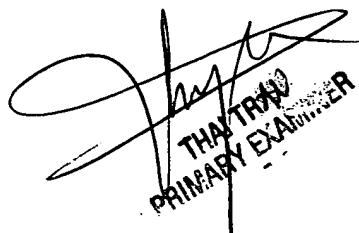
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should

be directed to Customer Service whose telephone number is (703) 306-0377.

  
COO

4/28/05

  
THAYNE T. TRACY  
PRIMARY EXAMINER